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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,616	11/01/2006	Ulrike Rockrath	PAT-00 330	3608
26922	7590	03/31/2008	EXAMINER	
BASF CORPORATION			FRANK, NOAH S	
Patent Department				
1609 BIDDLE AVENUE			ART UNIT	
MAIN BUILDING			PAPER NUMBER	
WYANDOTTE, MI 48192			1796	
			NOTIFICATION DATE	
			DELIVERY MODE	
			03/31/2008	
			ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/595,616	<b>Applicant(s)</b> ROCKRATH ET AL.	
	<b>Examiner</b> NOAH FRANK	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/1/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woltering et al. (WO 02/38685, citations based on English equivalent, US 7,041,729) in view of Mayer et al. (EP 0 708 788, citations based on English equivalent, US 6,372,875).

Considering Claims 1-2, 5-6, 9: Wolterling et al. teaches pseudoplastic powder clearcoat slurries comprising particles which are solid and/or high viscosity and are dimensionally stable under storage and application conditions and comprise as binder at least one polyol (Abs). The binder will therefore be incorporated into the dimensionally stable particles. The slurry also comprises water (8:60-65) and hence is aqueous. The binder preferably has a minimum film-forming temperature (T<sub>g</sub>) greater than 30°C (8:40-45), must carry hydroxyl groups (i.e. it is a polyol) (4:15-20), and may be polyurethanes (4:35-45). Wolterling teaches the highly suitable polyurethanes being those described in EP 0 708 788 (5:15), which comprise cycloaliphatic diisocyanates such as isophorone diisocyanate and dicyclohexylmethane diisocyanate (6:20-35 of Mayer). At the time of the invention a person of ordinary skill in the art would have found

it obvious to have used the polyurethanes, as taught in Mayer, in the invention of Wolterling, as the highly suitable polyurethanes taught in Wolterling (5:15 of Wolterling).

Considering Claim 3: Wolterling does not teach the polyol being a diol. However, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. MPEP 2144.05. The functionality of the polyol controls the amount of crosslinking, and subsequently the hardness of the coating. Consequently, it would be obvious to optimize. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. MPEP 2144.05.

Considering Claim 4: Wolterling does not teach the polyurethanepolyol being linear. However, Mayer et al. teaches using linear polyols in order to obtain a prepolymer of great flexibility (5:15-20). Wolterling and Mayer are combinable because they are from the same field of endeavor, namely polyurethane based coating compositions. At the time of the invention a person of ordinary skill in the art would have found it obvious to have made the polyurethanepolyols linear, as taught by Mayer, in order to make the final coating flexible.

Considering Claim 7: Wolterling teaches the polyurethanepolyols being those taught in Mayer et al. (EP 0 708 788) (5:15). Mayer et al. teaches using aliphatic or cycloaliphatic isocyanates (5:45-50), which would result in a polyurethane substantially free of aromatic structural units. At the time of the invention a person of ordinary skill in the art would have found it obvious to have used aliphatic or cycloaliphatic isocyanates,

as taught by Mayer, in the invention of Wolterling as the highly suitable polyurethanes taught in Wolterling (5:15 of Wolterling).

Considering Claim 8: Wolterling teaches the polyol binder present in an amount from 9 to 60% by weight, based on the solids of the powder slurry (5:25-30).

Considering Claims 11-12: Wolterling teaches using the slurry of the invention as a coating for automotive finishing, construction coating, coil coating, and container coating (10:10-20).

Claim 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Wolterling et al. (WO 02/38685, citations based on English equivalent, US 7,041,729) in view of Mayer et al. (EP 0 708 788, citations based on English equivalent, US 6,372,875).

Considering Claim 13: Wolterling et al. teaches pseudoplastic powder clearcoat slurries comprising particles which are solid and/or high viscosity and are dimensionally stable under storage and application conditions and comprise as binder at least one polyol (Abs). The binder will therefore be incorporated into the dimensionally stable particles. The system is diluted with water (8:15-20) and hence is aqueous. The binder preferably has a minimum film-forming temperature ( $T_g$ ) greater than 30°C (8:40-45), must carry hydroxyl groups (i.e. it is a polyol) (4:15-20), and may be polyurethanes (4:35-45). Wolterling teaches the highly suitable polyurethanes being those described in EP 0 708 788 (5:15), which comprise cycloaliphatic diisocyanates such as isophorone diisocyanate and dicyclohexylmethane diisocyanate (6:20-35 of Mayer). At the time of the invention a person of ordinary skill in the art would have found it obvious to have

used the polyurethanes, as taught in Mayer, in the invention of Wolterling, as the highly suitable polyurethanes taught in Wolterling (5:15 of Wolterling).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NOAH FRANK whose telephone number is (571)270-3667. The examiner can normally be reached on M-F 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/David Wu/  
Supervisory Patent Examiner, Art Unit 1796